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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 9

Application Number: 09/661,520
Filing Date: September 13, 2000
Appellant(s): WILK, PETER J.

R. Neil Sudol
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 17, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,316,516	Saitoh	05-1994
4,923,428	Curran	05-1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh.

In re claims 1-5, Saitoh disclosed a novelty item comprising a housing (1) in the form of a bird, a sound reproduction system (43) mounted in the housing so as to remain hidden from casual visual inspection of the housing, a switch (44) mounted in the housing and operatively connected to the sound system (43) for activating same in response to a moving of the housing near a human body. The switch or sensor (44) may be pyroelectric sensor for detecting infrared rays radiated from a human body (see column 4, lines 17-20). The sound reproduction of Saitoh inherently includes a power source, a solid-state memory (46) that includes a conventional electro-acoustic transducer (47). It is noted that Saitoh did not specifically teach the housing is in the form of a seashell, and other types of switches such as gravity or proximity sensors as set forth in these claims. However, the difference in the shape of the housing appears to be merely a matter of design choice and does not contain any structural significance. Therefore, it would have been a matter of design choice to one skilled in the art to

modify the housing of Saitoh with any desired shape or figure to accommodate any specific environment.

Regarding the different types of switches, the specification of this application indicated that different types of switches are merely alternative forms of a sensor (see pages 6-8 of this application) and one sensor does not appear to have any significant advantage over the others. Therefore, it would have been obvious to one of ordinary skill in the art to modify the sensor (44) of Saitoh with any equivalent sensor that is commercially available.

Regarding claims 7-12, 14-16, it is noted that Saitoh teaches that the sensor (44) detects infrared rays emitted from a person causing the control circuit (45) to actuate the sound system (43) (see column 4, lines 31-39). It is noted that Saitoh does not specifically teach a step of after and only after a removal of the housing from a stationary position towards an ear of a user, a sound is reproduced. On page 7 of the present application, one of the alternative switches may be infrared sensor 32 (Fig. 5) for detecting the temperature of a body placed next to mouth opening 12. It is submitted that since the sensor (44) of Saitoh is virtually same as one of the alternative sensors as disclosed by the applicant, the infrared sensor of Saitoh is certainly more than capable of being programmed and/or adjust to detect the temperature of an ear of the user.

Claims 6, 13, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh as applied to claim 1 above, and further in view of Curran U.S. Patent 4,923,428.

It is noted that the sound reproduction system (43) of Saitoh failed to show a memory storing a plurality of different sound bits and means for accessing different one of the sound bits on successive activations of the sound reproduction system by the switch. However, Curran teaches an interactive talking toy having a sound reproduction system with a memory (36) storing a plurality of different sound bites (39, 41, 43) (see column 2, lines 53-60), and means (55) (see column 3, and Fig. 4) for accessing different ones of the sound bites on successive activations of the sound system. Therefore, it would have been obvious to one of ordinary skill in the art to modify the sound reproduction system (43) of Saitoh with the a memory (36) and means (55) as taught by Curran for the purpose of providing a wide variety of sound to the user.

(11) Response to Argument

In response to applicant's argument that Saitoh failed to teach a switch connected to a sound reproduction system in a housing for activating that system after and only after the housing is lifted to an ear of a user as set forth in claims 1, 7-10, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As discussed above, since the sensor (44) of Saitoh is same as one of the alternative sensors as disclosed on pages 6-8 of the present application, the


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sensor of Saitoh is certainly capable of performing the intended use as set forth in claims 1, 7-10.

In response to applicant's argument concerning claims 13, 17, and 18 that the features of the bird as taught by Saitoh cannot be combine with the features of a doll, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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May 20, 2002

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